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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,862	09/28/2001	Steven Oberste	14114.0353U2	8841

7590 05/05/2004
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EXAMINER

FOLEY, SHANON A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,862

Applicant(s)

OBERSTE ET AL.

Examiner

Shanon Foley

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 12-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 1648

DETAILED ACTION

In the amendment submitted October 2, 2003, applicant amended claims 1, 7 and 11.

Claims 1-46 are pending in the application.

Election/Restrictions

This application contains claims 3-5 and 12-46 drawn to an invention nonelected with traverse in Paper No. 9. It is noted that claim 1 has been amended to recite nonelected SEQ ID NOs: 20 and 21. Claims 7 and 8 also recite nonelected sequences. Applicant states on page 20 of the response that the oligonucleotides fall within the scope of elected group I and are not anticipated by the prior art. However, the restriction required that if group I was elected, a further election of a single pair of oligonucleotides was also required. Applicant elected group I and SEQ ID NOs: 19 and 22. Nonelected oligonucleotides do not share the same or corresponding special technical feature under the specific criteria for Markush practice for applications filed under 37 CFR § 371, see MPEP § 1850. They do not have a common property or activity and a common core structure and as a result, different products are generated when different oligonucleotides are substituted for one another. Therefore, each of the oligonucleotides lack unity of invention. A complete reply to the final rejection must include cancellation of nonelected claims and subject matter, or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1, 2 and 6-11 and elected SEQ ID NOs: 19 and 22 and the corresponding sequence motifs the primers hybridize to are under consideration.

Art Unit: 1648

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 6 and 9-11 are rejected under 35 U.S.C. 102(a) as being anticipated by Kilpatrick (WO 98/14611, provided in IDS) for reasons of record.

Applicant asserts that the amended claims recite oligonucleotides not disclosed by Kilpatrick or any other source.

Applicant's arguments and a review of Kilpatrick (WO 98/14611) have been fully considered, but are found unpersuasive. Claim 1 has been amended to recite, "wherein said mixture comprises at least one oligonucleotide..." and lists specific SEQ ID NOs, i.e. SEQ ID NO: 22. Kilpatrick anticipate using a primer that specifically hybridizes to the highly conserved sequence motif of instant SEQ ID NO: 86, see SEQ ID NO: 2 of claim 4 of Kilpatrick. Primer V3A of Kilpatrick anticipates SEQ ID NO: 22, see the sequence alignment provided in the previous Office action. Therefore, Kilpatrick anticipates using at least one oligonucleotide instantly claimed that hybridizes to a highly conserved sequence of an enterovirus nucleic acid.

Allowable Subject Matter

Claims 7 and 8 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1648

As explained in the previous Office action, the prior art does not teach or suggest a primer comprising SEQ ID NO: 19 or using a primer comprising SEQ ID NO: 22 with a primer comprising SEQ ID NO: 19.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

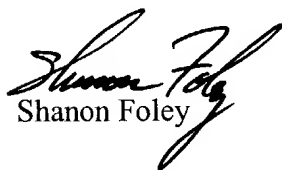
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (571) 272-0898. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1648

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shanon Foley